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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,547	06/26/2001	Kazuhiro Sugawara	35.C15492	9436
5514	7590	07/06/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				NGUYEN, QUANG N
		ART UNIT		PAPER NUMBER
				2141

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/888,547	SUGAWARA ET AL.
	Examiner Quang N. Nguyen	Art Unit 2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 May 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-12,14-27,29-35,38,40 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-12,14-27,29-35,38,40 and 43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 June 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Detailed Action

1. This Office Action is in response to the Amendment filed on 05/15/2006. Claims 1, 4-5, 7, 12, 15-16, 18, 23-24, 27, 29-30, 32, 38 and 40 have been amended. Claim 28 has been cancelled. Claims 1, 3-12, 14-27, 29-35, 38, 40 and 43 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 7-12 and 18-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwazaki (US 6,687,742).**

4. As to claim 1, Iwazaki teaches a communication control method and system, comprising:

an email transmitting unit, adapted to send email data accompanied by an image

file (*Internet facsimiles 3 and 8 have both unit functioning in transmission/reception emails with attached image*) (**Iwazaki, C4:L56 - C5:L4**);

an email receiving unit, adapted to receive email data (*Internet facsimiles 3 and 8 have both unit functioning in transmission/reception emails with attached image*) (**Iwazaki, C4:L56 - C5:L4**);

a requesting unit, adapted to add, selectively, information for requesting a message disposition notification "MDN" to the email data to be sent to a receiver by said email transmitting unit (a request for an MDN message is made by adding a "Disposition Notification-To:" field to the header of an email to be transmitted to a receiver) (**Iwazaki, C6: L39-48**);

a communication managing unit, adapted to manage transmission information of each of plural bodies of sent email data (the processing result from the MDN response message is recorded in transmission history information) (**Iwazaki, C7: L61-64**); and

a judgment unit, adapted to judge whether or not the sending of the email data succeeded, based on the message disposition notification received by said email receiving unit and responsive to the sent email data to which the information for requesting the message disposition notification is added (*in step S36 of Fig. 10, the receiver describes the processing result in an MDN message and transmits the message to the sender which records the processing result in the returned MDN message in the transmission history information*) (**Iwazaki, Fig. 10 and C13: L45-55**),

wherein the transmission information includes information showing a result of the sending of the email data performed by said email transmitting unit (the receiver

describes the processing result of the received message in an MDN message and transmits the MDN message to the sender) (Iwazaki, C13: L45-55), and

 said communication managing unit updates the information showing the result of the sending of the email data included in the transmission information, based on a judgment by said judgment unit (the sender records the processing result in the returned MDN message in the transmission history information) (Iwazaki, C13: L45-55)).

5. As to claim 7, Iwazaki teaches a communication control method and system, comprising:

 an email receiving unit, adapted to receive email data accompanied by an image file (*Internet facsimiles 3 and 8 have both unit functioning in transmission/reception emails with attached image) (Iwazaki, C4:L56 - C514)*);

 a detecting unit, adapted to detect control information which requests reply email from the email data received by said email receiving unit (*the email analyzing section 26 checks the user defined field in the header of the received email message for control information requesting reply email) (Iwazaki, C7: L28-43)*; and

 a notifying unit, adapted to notify a user of said image communication apparatus that the email data having the control information was received (*an Internet facsimiles such as a personal computer having means such as a liquid crystal display/screen for presenting various kinds of information to the user*), based on the detection of the control information from the email data by said detecting unit (*when the receiver recognizes or is notified those identification/control information "X-flag: capability*

request" by the email analyzing section 26, the email generator 25 generates an MDN message and returns the MDN message to the sender) (Iwazaki, C7: L28-43).

6. As to claim 8, **Iwazaki** teaches the apparatus of claim 7, wherein said notifying unit performs the notification before contents of the email of which the control information was detected are visually outputted (*when the receiver recognizes the identification information, the email generator 25 generates an MDN message and returns the MDN message to the sender*) (Iwazaki, C7: L28-43 and C9: L51-56).

7. As to claim 9, **Iwazaki** teaches the apparatus of claim 7, further comprising an output unit, adapted to visually output contents of the image file attached to the received email, wherein the image file attached to the email of which the control information was detected is visually outputted (*each of the Internet facsimiles 3 and 8 comprises unit for processing the image attached to the email*) (Iwazaki, C10: L46-61), said notifying unit adds information indicative of the detection of the control information to a part of said image (*information indicating the control method of the receiver and a capability response as information identifying the type of that email is added to the MDN message*) (Iwazaki, C9: L51-61).

8. As to claim 10, **Iwazaki** teaches the apparatus of claim 9, wherein when the image file attached to the email of which the control information was detected is visually outputted, if the reply email responsive to the control information has already been sent,

said notifying unit adds information indicative of a completion of a response to the control information to a part of said image (*in step S36 of Fig. 10, the receiver describes the processing result in an MDN message and transmits the message to the sender which records the processing result in the returned MDN message in the transmission history information*) (**Iwazaki, Fig. 10 and C13: L45-55**).

9. As to claim 11, **Iwazaki** teaches the apparatus of claim 7, wherein the control information is information for requesting reply email indicative of a message disposition notification "MDN" of the email (*a request for an MDN message is made by adding a "Disposition Notification-To:" field to the header of an email to be transmitted to a receiver*) (**Iwazaki, C6: L39-48**).

10. Claim 12, 23 and 25 are corresponding method, computer program and computer-readable memory medium claims of apparatus claim 1; therefore, they are rejected under the same rationale.

11. Claims 18-22 are corresponding method claims of apparatus claims 7-11; therefore, they are rejected under the same rationale.

12. Claims 24 and 26 are corresponding computer program and computer-readable memory medium claims of apparatus claim 7; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-6 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki, in view of Miyamoto (US 6,327,046), hereinafter "Miyamoto".

15. As to claim 3, **Iwazaki** teaches the apparatus of claim 1, but does not explicitly teach a selecting unit, adapted to select ON/OFF of an execution of said requesting unit, wherein said communication managing unit manages ON/OFF of the request of the message disposition notification as transmission information for every sent email.

In an analogous art, **Miyamoto** teaches an electronic mail processing apparatus and method comprising a selecting part for selecting whether a request for reply to an electronic mail to be transmitted is to be made or not by marking the check box 19 in Fig. 5 to turn ON a reply email request (Miyamoto, Fig. 5 and C6: L16-32). **Miyamoto** also teaches that if a reply from the receiver of the email has been sent, the task finish flag 11-4-5 in the Todo task list storage section 11-4 of the RAM 11 is set to be "1" (i.e., *update the transmission information on the basis of whether or not said requesting unit requests the reply email responsive to the sent email*) (**Miyamoto, C6:L62 - C7:L18**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Iwazaki** and **Miyamoto** to include a selecting unit, adapted to select and manage ON/OFF of the request of the message disposition notification as transmission information for every sent email since such methods were conventionally employed in the art to allow the sender to select whether a request for reply (or a *request for message disposition notification*) to an email from the receiver to be made or not at the time of transmitting the email and to specify a due date of reply and to retransmit the same email automatically when no reply has been received within a predetermined period of time.

16. As to claim 4, **Iwazaki-Miyamoto** teaches the apparatus of claim 1, wherein said communication unit updates the transmission information to first information showing that the message disposition notification responsive to said sent email data has been received (*i.e., the task finish flag 11-4-5 is set to “1”, the item is displayed as a processed task with a check mark*) (**Miyamoto**, **C7: L6-18 and C8: L19-32**).

17. As to claim 5, **Iwazaki-Miyamoto** teaches the apparatus of claim 1, wherein said communication unit updates the transmission information to second information showing that the message disposition notification responsive to the sent email data was not received within a predetermined period of time (*i.e., the task finish flag is set to “0”, the item is displayed as an unprocessed task*) (**Miyamoto**, **Fig. 7 and C7: L6-21**).

18. As to claim 6, **Iwazaki-Miyamoto** teaches the apparatus of claim 1, further comprising output unit for visually outputting the transmission information, which is managed by said communication managing unit (**Miyamoto, Figs. 7-8 and C7: L6-21**).

19. Claims 14-17 are corresponding method claims of apparatus claims 3-6; therefore, they are rejected under the same rationale.

20. **Claims 27, 29-32, 34-35, 38, 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta (US 6,396,848), in view of Wing (US 6,650,440).**

21. As to claim 27, **Ohta** teaches an image communicating apparatus for sending and receiving image information through a communication network, comprising:

an email unit, adapted to send and receive email via an email server (*network facsimile apparatus 2 sending and receiving email via POP server 3*) connected to the communication network (**Ohta, Fig. 1, C5:L61 - C6:L5**);

a memory unit, adapted to store communication management information of the email (*a hard drive unit 25 for storing communications information and image information through various communication operations*) (**Ohta, Fig. 2, C6: L27-32 and C7: L11-25**);

a communication management information forming unit, adapted to, each time the email is sent by said email unit, form communication management information of the

sent email and store the communication management information into said memory unit (*network facsimile apparatus 2 performs various communications operations to extract image/communications information for storing in the hard drive unit 25*) (**Ohta, Fig. 6 and C11:L47 - C12:L65**);

an updating unit, adapted to update information showing a transmission result of the sent email included in the communication management information of the sent email, based on a judgment result by said judgment unit (*the information transfer operation indices of the communications history file 41 includes/updates a result for representing a communication result with an "OK" mark for a normal completion or a "NG" mark for an abnormal completion*) (**Ohta, Fig. 7 and C14: L20-22**); and

a communication management report output unit, adapted to output a communication management report indicative of the communication management information stored in said memory unit (*outputting the communications history report 42 as illustrated in Fig. 9*) (**Ohta, C14: L46-52**).

However, **Ohta** does not explicitly teach a judgment unit, adapted to judge whether or not the sending of the email succeeded, based on a delivery status notification for the sent email from said email server.

In an analogous art, **Wing** teaches a communication system for transmission of facsimile information using an email message from a sending fax device to a receiving fax device through mailer devices including a sending gateway device and a receiving gateway device, wherein a DSN (Delivery Status Notification) confirmation request message is attached with the sent email message and can generate four types of

responses: "Relay DSN", "Delivery Success", "Delivery Failure", and "Delayed Delivery"
(Wing, C9: L31-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Ohta** and **Wing** to include a judgment unit, adapted to judge whether or not the sending of the email succeeded, based on a delivery status notification for the sent email from said email server since such methods were conventionally employed in the art to allow the system to inform the sending user of the status of the delivery of the message.

22. As to claim 29, **Ohta-Wing** teaches the apparatus of claim 27, wherein the delivery status notification for the sent email from said email server is a notification showing one of a failed notification, a delayed notification, a normal end of transmission notification, and a relayed notification as a transmission result of the sent email (**Wing, C9: L31-37**).

23. As to claims 30-31, **Ohta-Wing** teaches the apparatus of claim 27, further comprising discriminating unit, adapted to discriminate whether the delivery status notification for the sent email from said email server has been received by said email unit after the elapse of a predetermined period of time from the transmission of the email or not (**Wing, C9:L38 -C10:L28**), and said updating unit updates the transmission result of the communication management information of the email which received the delivery status notification in accordance with the received delivery status notification,

and said communication management report output unit outputs a communication management report in which the transmission result was updated as a communication management report of the sent email (*outputting an "OK" for a normal completion or a "NG" for an abnormal completion, i.e., error notification, to the communications history report 42 as illustrated in Fig. 9*) (Ohta, C14a-46-52).

24. Claims 32 and 34-35 are corresponding apparatus claims of apparatus claims 27 and 29-31; therefore, they are rejected under the same rationale.

25. Claim 38, 40 and 43 are corresponding method, computer program and computer-readable memory claims of apparatus claim 27; therefore, they are rejected under the same rationale.

26. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta-Wing, in view of Matsueda et al. (US 6,301,016), herein after referred as Matsueda.

27. As to claim 33, Ohta-Wing teaches the apparatus of claim 32, but does not explicitly teach said error notification information output unit comprises unit for generating a warning sound as said error notification information.

In an analogous art, **Matsueda** teaches a data processing apparatus, such as a facsimile apparatus that transmits and/or receives data to and from another apparatus, comprising a loud speaker for generating a sound warning of the occurrence of an error or failure (**Matsueda, C18: L23-25**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Ohta-Wing** and **Matsueda** to include unit for generating a warning sound as said error notification information since such methods were conventionally employed in the art: to warn the user about the error, to give the user the information of the error occurrence, thereby allowing the user to take proper action for the error (**Matsueda, C19: L8-29**).

Response to Arguments

28. In the remarks, Applicant argued in substance that

(A) Prior Arts do not teach or suggest "a judgment unit for judging whether the sending of the transmission information concerning the sent email data succeeded, based on the message disposition notification (MDN) received by the email receiving unit, the sent email data requesting the MDN, and the communication managing unit updating the information showing the result of the sending of the email data included in the transmission information, based on the judgment of the judgment unit", as recited in claim 1.

As to point (A), **Iwazaki** teaches a judgment unit for judging whether the sending of the transmission information concerning the sent email data succeeded, based on the message disposition notification (MDN) received by the email receiving unit (*after receiving the email message in step 34 of Fig. 10, the receiver performs a process, such as printing/displaying the attached image in step 35. Then in step S36, the receiver describes the processing result in an MDN message and transmits the message to the sender which records the processing result in the returned MDN message in the transmission history information*) (**Iwazaki, Fig. 10 and C13: L45-55**),

*the sent email data requesting the MDN (a request for an MDN message is made by adding a "Disposition Notification-To:" field to the header of an email to be transmitted to a receiver) (**Iwazaki, C6: L39-48**), and*

*the communication managing unit updating the information showing the result of the sending of the email data included in the transmission information, based on the judgment of the judgment unit (the sender records the processing result contained in the returned MDN message in the transmission history information) (**Iwazaki, C13: L45-55**).*

(B) Prior Arts do not teach or suggest "notifying the user of the image communication apparatus that the email having the control information was received, based on the detection of the control information from the Email", as recited in claim 7.

As to point (B), **Iwazaki** teaches a notifying unit, adapted to notify a user of said image communication apparatus that the email data having the control information was

received (an Internet facsimiles such as a personal computer having means such as a liquid crystal display/screen for presenting various kinds of information to the user), based on the detection of the control information from the email data by said detecting unit (when the receiver recognizes or is notified those identification/control information "X-flag: capability request" by the email analyzing section 26, the email generator 25 generates an MDN message and returns the MDN message to the sender) (Iwazaki, C7: L28-43).

29. Applicant's arguments as well as request for reconsideration filed on 05/15/2006 have been fully considered but they are not deemed to be persuasive.

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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